

*Application No. 10/699958**Amendment**Page 4**Attorney Docket No. M113.2N-10592-US02***Remarks**

This Amendment is in response to the Office Action dated **April 7, 2006**.

In the Office Action the Examiner initially rejected claims 18-33 asserting 35 U.S.C. §103 over U.S. Patent No. 6,315,152 to Kalisz.

In the Office Action, dated April 7, 2006, the Examiner asserted that:

The main goal of the bracket of Kalisz is to secure the tubes when not in use by magnetic attachment. In view of this teaching it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the tubes themselves out of magnetic material in order to achieve the same goal of Kalisz with less parts and without needing a complex part having a very specific necessary shape.

For the below identified reasons, Applicant specifically traverses the assertions of the Examiner related to the Kalisz '152 reference.

One embodiment of the Kalisz '152 invention is disclosed in the Abstract which identifies the invention as a sleeve having two resilient wings which define a slot between the free ends of the wings, where the aerosol can engages the interior surface of the wings, causing the slot to deform apart and return toward an original width to grasp a can. The sleeve also includes a cavity adapted to receive a tube. In this embodiment, the sleeve is mechanically engaged to the exterior of an aerosol can. In addition, a tube is mechanically engaged to the sleeve via a cavity. No reference is made to any magnetic component in this embodiment.

In the background column 1, lines 39-46 the Kalisz '152 reference discloses the use of a single, plastic hollow extension tube for use with an aerosol can. In column 1, lines 49-52, the Kalisz '152 reference discloses the use of a red, polypropylene WD-40® extension tube that is used in conjunction with the WD-40® spray can.... In addition, in column 1, lines 60-62, the tube is disclosed as being attached to the exterior surface of the can through the use of adhesive tape. (Columns 1 and 2, lines 59-12.)

In column 2, line 13, Kalisz '152 reference identifies the use of the plastic tube.

In column 2, lines 27-46, Kalisz '152 identifies the problem to be solved as the Mylar tape being insufficiently rigid to withstand repeated insertions and removals of the tube, where the failure of the Mylar tape results in the absence of a mechanism to store the tube in

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conjunction with the aerosol can.

In the background, column 1, lines 1-67, and column 2, lines 1-67, no disclosure or suggestion is provided related to the magnetic attraction with respect to any element. In fact, in the background, columns 1 and 2, are directed exclusively to mechanical engagement of a tube to the exterior surface of an aerosol can.

In column 3, lines 1-29, Kalisz '152 discloses the mechanical attachment of a tube to a can and the problems with the art as known.

In the summary of the invention, column 3, lines 31-44, Kalisz '152 discloses an embodiment where a sleeve has two resilient wings defining a slot between the free ends of the wings, where the wings deform apart to return towards an original width as the aerosol can passes within the slot. This is the mechanical engagement of the sleeve to the can. The summary also discloses the mechanical engagement of the tube in a cavity in the sleeve. The summary makes no reference to any magnetic component.

In the detailed description of the invention, column 4, line 10, the Kalisz '152 reference discloses the tube as a plastic, hollow extension tube.

In column 4, lines 41 to column 5, lines 32, the Kalisz '152 reference discloses a preferred embodiment as having a sleeve having two side wings to form a bow defining an axial slot, where the side wings are elastically deformable for clipping to the exterior of the aerosol can as passing through the axial slot. The sleeve is also disclosed as including a cavity to retain a tube where the cavity is tapered. In the preferred embodiment, the sleeve is mechanically engaged to the exterior surface of the can and the tube is mechanically engaged to the tapered cavity. No suggestion or reference is made to any magnetic component in the preferred embodiment.

Another embodiment to the Kalisz '152 invention is disclosed in column 5, lines 34-49. This embodiment discloses the use of a sleeve of the preferred embodiment, where the cavity 38 is replaced with a recessed portion to hold the tube between the aerosol can and the wings of the sleeve, where the tube is in direct contact with the aerosol can. This alternative embodiment also fails to provide any disclosure or suggestion related to any magnetic component of the invention.

Another embodiment to the Kalisz '152 invention is disclosed in column 5, lines

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50-lines 63. This embodiment discloses the use of a sleeve of the preferred embodiment, where the cavity 38, and recessed portion 50, are replaced with a peg 60 onto which the hollow tube may be inserted. This alternative embodiment is also directed to the mechanical engagement of the sleeve to the aerosol can, as well as the mechanical engagement of the tube to the sleeve. This alternative embodiment fails to provide any disclosure or suggestion related to any magnetic component of the invention.

Another embodiment of the Kalisz '152 invention is disclosed in column 5, line 64 through column 6, line 18. This embodiment discloses the use of a ring 100 as a replacement for the sleeve. The ring 100 is mechanically mounted onto an aerosol can. The ring 100 includes a cavity 35, recessed portion 50, or a peg 60, to mechanically engage a tube to the ring 100. The ring 100 is disclosed as being formed of rubber of a single piece construction. The ring 100 may also include a mechanical hinge 102. This alternative embodiment fails to provide any disclosure or suggestion related to any magnetic component of the invention.

Another embodiment of the Kalisz '152 invention is disclosed in column 6, lines 19-46. In this embodiment, the invention is disclosed as including a base 200 in replacement of a ring 100 or a sleeve 30. The base 200 is mechanically coupled to the bottom of the aerosol can (Fig. 8) through the annular rim 206, which forms a lip 208 as positioned over ridge 22B through an overlapping rim-ridge configuration. This alternative embodiment fails to provide any disclosure or suggestion related to any magnetic component of the invention. In this embodiment, the tube is mechanically engaged to the cavity 38, recessed portion 50, or peg 60 as earlier described.

In another alternative embodiment as disclosed in column 6, lines 47-58, the sleeve 30, ring 100, base 200, or body 300, may be formed of magnetic material to secure the sleeve 30, ring 100, base 200, or body 300, to the exterior of the aerosol can. In this embodiment, the sleeve 30, ring 100, base 200, or body 300, includes the mechanical cavity 38, recessed portion 50, or peg 60, adapted to mechanically engage the tube.

The embodiments disclosed in the Kalisz '152 patent with the exception of Fig. 8 are disclosed as being preferably formed of ABS injected molded plastic material.

In seven of the eight embodiments described in the Kalisz '152 reference, the sleeve 30, ring 100, base 200, and/or body 300, are disclosed as being mechanically and not

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magnetically attached to the exterior surface.

In eight of the eight embodiments disclosed in the Kalisz '152 reference, the tube is disclosed as being mechanically, not magnetically, engaged to the cavity 38, recessed portion 50, and/or peg 60.

In no embodiment, is the Kalisz '152 invention disclosed as eliminating the sleeve 30, ring 100, base 200, or body 300, for direct and exclusive engagement of the tube to the exterior of the aerosol can through magnetic attraction.

#### RECORDING HERE

In addition, in the case of *In Re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (CAFC 1999) the Court of Appeals for the Federal Circuit has stated that the "very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome where that which only the inventor taught is used against its teacher". The Court of Appeals for the Federal Circuit has stated that the case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references in that one of ordinary skill in the art would have been motivated to select the references and combine them, and it was error to not elucidate any factual teachings, suggestions, or incentives from the prior art that showed the propriety of the combination. The Federal Circuit in *Dembiczak* further stated that combining prior art references without evidence of such suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability which is the essence of hindsight.

A person skilled in the art reviewing the Kalisz '152 reference without the benefit of hindsight, as afforded by Applicant's disclosure, would not have gleaned a suggestion to completely eliminate the sleeve 30, ring 100, base 200, or body 300 for direct magnetic engagement of a tube to the exterior surface of an aerosol can. The Kalisz '152 reference makes no such disclosure.

A person skilled in the art reviewing the Kalisz '152 reference, without the benefit of hindsight, as afforded by Applicant's disclosure, would not have gleaned a suggestion to magnetically connect a tube to a sleeve 30, ring 100, base 200, or body 300. All that is disclosed in the Kalisz '152 reference is the mechanical engagement of a tube to a sleeve 30, ring 100, base

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200, and/or body 300, through the use of a cavity 38, recessed portion 50, or peg 52.

The Kalisz '152 patent does not suggest to a person of ordinary skill in the art the elimination of the bulky sleeve 30, ring 100, base 200, and/or body 300. Kalisz '152 does not suggest or teach the use of a magnetic tube.

Applicant therefore respectfully traverses the assertion by the Examiner that the main goal of the Kalisz '152 reference is to secure the tube, when not in use, by magnetic attraction to the can. The main goal of the Kalisz '152 reference, in seven of the eight embodiments identified, is to mechanically engage a sleeve, ring 100, base 200, and/or body 300 to an aerosol can, and in all embodiments to mechanically engage a tube to a cavity 38, recessed portion 50, or peg 60.

The eighth embodiment of Kalisz '152 provides disclosure of an intermediate carrier such as a sleeve 30, ring 100, base 200, and/or body 300 which is magnetically attached to the exterior surface of an aerosol can. The eighth embodiment of the Kalisz '152 reference fails to provide any disclosure, suggestion, and/or teaching related to the use of a magnetic tube. The Kalisz '152 reference is restricted to the exclusive mechanical attachment of the tube within the cavity 38, recessed portion 50, and/or peg 60.

Applicant therefore respectfully requests that the Examiner withdraw the rejection of claims 18-33 pursuant to 35 U.S.C. §103 over Kalisz '152.

The Examiner next rejected claims 18-33 asserting 35 U.S.C. §103 Kalisz '152 in view of Goodman '034.

The Goodman '034 patent is directed exclusively to the magnetic detection of an underground pipe. In Goodman '034 the pipe may include particles of magnetic material embedded in the plastic or secured to a pipe wall.

Applicant respectfully asserts that the Goodman '034 reference is non-analogous art, and would not have been used by a person of ordinary skill in the art at the time of Applicant's invention. A person of ordinary skill in the art working on the problem of attachment of a tube to an aerosol can, would not have looked to the magnetic detection of underground pipe, to provide assistance in the invention as disclosed and claimed in the present application.

No disclosure is provided in Kalisz '152 for combination with Goodman '034.

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No disclosure is provided in Goodman '034 for combination with Kalisz '152. The teachings of magnetic detection of underground pipe is significantly removed from the teachings of mechanical attachment of a sleeve 30, ring 100, base 200, or body 300, to an aerosol can, and the mechanical attachment of a tube to a cavity 38, recessed portion 50, or peg 60 of a sleeve, ring, base, or body, rendering any asserted combination of the references under 35 U.S.C. §103 inappropriate.

A person of ordinary skill in the art would not have looked to the combination of references as asserted by the Examiner at the time of Applicants invention. Applicant respectfully asserts that the rejections under 35 U.S.C. §103 herein impermissibly applies hindsight, and uses Applicants disclosure as a blueprint to reject Applicants claims. Applicant therefore respectfully requests that the Examiner withdraw the rejection of claims 18-33 pursuant to the asserted combination of Kalisz '152 in view of Goodman '034.

It is recognized that dependant claims are non-obvious under §103 if the independent claims from which they depend are non-obvious. *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987); *In re Abele*, 684 F.2d 902, 910, 241 USPQ 682, 689 (CCPA 1982); see also *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, claims 18-33 are in condition for allowance and withdrawal of the rejection is respectfully requested.

For the above-identified reasons, Applicant respectfully asserts that claims 18-33 herein are in condition for allowance. Early action to that effect is earnestly solicited. If the Examiner has any questions concerning the enclosed amendment and remarks, the Examiner is cordially invited to contact the same by telephone E-mail, and/or facsimile.

Should the Examiner have any questions concerning this Amendment, then the Examiner is cordially invited to contact the undersigned by telephone, facsimile, and/or E-Mail at the below identified address. If an extension of time is required to make this response timely and no separate petition is enclosed, Applicant hereby petitions for an extension of time sufficient to make the response timely. In the event that the response herein requires the payment of additional government fees and payment is not enclosed, please charge Deposit Account No. 22-0350.

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**Conclusion**

It is believed that claims 18-33 in the present application are in condition for allowance in view of the foregoing. Applicant respectfully requests reconsideration of the claims herein and that the rejections be withdrawn and the claims allowed. Applicant respectfully requests the Examiner to reconsider the claims as amended herein which Applicant believes puts the application in condition for allowance. Early action to that effect is earnestly solicited.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: June 27, 2006

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